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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,923	12/03/2001	Isabelle Conesa	110652	3020

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Oliff & Berridge
P O Box 19928
Alexandria, VA 22320

EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,923

Applicant(s)

CONESA ET AL.

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 7-24 and 27-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/20/01.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-6 and 25-26 in Paper No. 11, is acknowledged. The traversal is on the ground(s) that the appropriate unity of invention standards have not been properly applied by the Patent Office because Groups I-VIII share the common technical feature of Group I and the process of Group IX can impart unexpected properties to the products of Groups I-IV. Applicants further argue that no undue burden exists. This is not found persuasive because a group of inventions is considered linked to form a single inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical feature is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. Lack of unity of invention may be evident when a prior art document shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In the instant case, the special technical feature of the present invention can be construed to be a composition comprising acrylic resin, intumescent agent and a plasticizer. GB 2079801A teaches a composition comprising acrylic resin, intumescent agent and plasticizer. Accordingly, applicants' special technical feature does not define a contribution that the claimed inventions make over the prior art. Therefore, lack of unity is proper. In addition, applicants are reminded of the combinations of categories of inventions. The claims of

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the present application do not adhere to said categories and contain multiple products and uses. This would result in an undue burden on the examiner in examining all of the claims.

The requirement is still deemed proper and is therefore made FINAL.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 and 25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the weight proportion of a plasticizing medium comprising a phosphate that is at most equal to 200% with respect to the weight of acrylic resin, does not reasonably provide enablement for a plasticizing medium comprising a phthalate that is at most equal to 200% with respect to the weight of acrylic resin. In addition, the specification, while being enabling for the weight of the plasticizing medium being 125.00 parts or 130.00 parts, does not reasonably provide enablement for the weight of the plasticizing medium being between 120 and 145% by weight of resin. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. In particular, the specification does not

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provide support for a plasticizing medium comprising a phthalate that is at most equal to 200% with respect to the weight of acrylic resin nor does the specification provide support for the proportion of the plasticizing medium being between 120 and 145% by weight of resin.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 recites the limitation "wherein the weight proportion of the plasticizing medium comprising a phthalate is" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-6 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferziger et al, 4,801,493 (Ferziger) in view of Dias et al, 4,256,786 (Dias) and Hudecek et al, 3,971,744 (Hudecek).

Ferziger teaches coated fiberglass fabrics having a polymer based coating composition; said composition comprising a polymeric carrier containing a plasticizer and a flame retardant and, if desired, a filler that functions as a flame retardant. See column 4, lines 1-9. The polymeric carrier can be an acrylic resin and the plasticizer can be an organic phosphate as required by claims 1 and 3. See column 4, lines 20-22 and 30-37. Ferziger does not teach the inclusion of an intumescent agent or a phthalate as the plasticizing agent.

Dias teaches a chemical protective fire resistant composition comprising a phosphoric acid releasing fire retardant such as ammonium polyphosphate (which upon decomposition forms a cellular foam crust upon the coated substrate) and a binder such as acrylic resin. See column 1, lines 56-61. The composition is used to impart fire resistant properties to plastic foam and textile articles.

It would have been obvious at the time the invention was made to modify the composition taught by Ferziger by including a phosphoric acid releasing fire retardant in order to impart flame retardant properties to the substrates of Ferziger while protecting the surfaces of said substrates. As to claims 2 and 4, it is the examiner's position that the utility of a phthalate plasticizer is no more than a preferential selection of one plasticizer from among many used for its art recognized purpose, which is not construed to be a matter of invention in the absence of a clear showing of unexpected or superior

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properties in the resultant composition, said properties being directly related to the specific plasticizing medium. In the alternative, Hudecek teaches a method for forming emulsions, dispersions and pastes, said method consisting of polymerizing monomers in a plasticizing medium. The monomers can be acrylic based monomers and the plasticizers can be phosphates or phthalates. See column 2. This teaching would have provided a suggestion to the skilled artisan that plasticizers such as phosphates and phthalates could be used in compositions containing acrylic resins with a reasonable expectation of success of providing the desired physical and processing properties to the resultant composition.

As to the limitation of the composition exhibiting Newtonian rheological behavior with a viscosity of less than 6000mPa.s at low shear rates and pseudoplastic rheological behavior at high shear rates, it is the examiner's position that these properties are inherent in the composition of the prior art. As to claims 5 and 25, Hudecek teaches amounts of the plasticizing medium within applicants' range. See Examples. As to claims 6 and 26, it is the position of the examiner that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233 (CCPA 1955).

Therefore, when considered as a whole the combined teachings of Ferziger, Dias and Hudecek would have rendered obvious the invention as claimed in the present claims.

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Claims 1-6 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain Publication No. 2,079,801 A (Bridge) in view of Hudecek et al, 3,971,744, as applied above to claims 1-6 and 25-26, (Hudecek).

Bridge teaches glass fabrics treated with a composition comprising ammonium polyphosphate, a plasticizer and an acrylic latex binder as required by claim 1. See page 1, lines 41-56. Bridge is silent as to a phthalate or phosphate plasticizer. Hudecek, as set forth above, teaches a method for forming emulsions, dispersions and pastes, said method consisting of polymerizing monomers in a plasticizing medium. The monomers can be acrylic based monomers and the plasticizers can be phosphates or phthalates, per claims 2-4. See column 2. This teaching would have provided a suggestion to the skilled artisan that plasticizers such as phosphates and phthalates could be used in compositions containing acrylic resins with a reasonable expectation of success of providing the desired physical and processing properties to the resultant composition. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of Bridge by using as the plasticizer any plasticizer known in the art, such as those taught by Hudecek with the reasonable expectation of obtaining the efficacious physical and processing properties in a composition associated therewith. As to the limitation of the composition exhibiting Newtonian rheological behavior with a viscosity of less than 6000mPa.s at low shear rates and pseudoplastic rheological behavior at high shear rates, it is the examiner's position that these properties are inherent in the composition of the prior art. As to claims 5 and 25, Hudecek teaches amounts of the plasticizing medium within

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applicants' range. See Examples. As to claims 6 and 26, it is the position of the examiner that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.

In re Aller, 105 USPQ 233 (CCPA 1955).

Therefore, when considered as a whole, the combined teachings of Bridge and Hudecek would have rendered obvious the invention as claimed in the present claims.

No claims are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

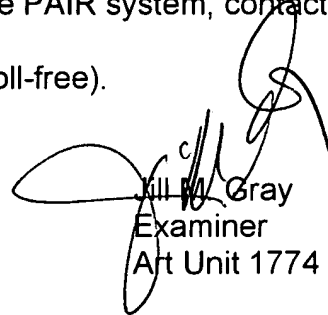
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on Monday-Thursday from 10:30 to 8:00. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray
Examiner
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